REMARKS

Reconsideration and withdrawal of the rejections to this application are respectfully requested in view of the following remarks which place the application in condition for allowance or into better condition for appeal.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 1 and 3-10 are pending. Claims 1 and 3 are amended and claim 2 is cancelled, without prejudice. No new matter is added.

It is submitted that these claims are patentably distinct from the prior art, and that these claims are in full compliance with the requirements of 35 U.S.C. §112. The remarks made herein are not made for the purpose of patentability within the meaning of 35 U.S.C. §§ 101, 102, 103 or 112; but rather the remarks are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. 35 U.S.C. §103 REJECTION

Claims 1-10 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,538,736 to Hoffmann et al. The rejection is traversed.

The instant invention is directed to a flat self-adhering plaster. The plaster has a multi-layer construction and reduced cold flow. The plaster is comprised of a layer of adhesive which attaches to skin having a core of adhesive made flowable by a plasticizing additive, and a ring of adhesive free of a plasticizing additive, wherein said ring has a reduced flowability to that of said core, wherein said ring surrounds said core, and wherein said core contains a pharmaceutical or active agent.

In a preferred embodiment, the instant invention has one drug reservoir—the core. Hoffmann, by contrast, teaches away from such an invention by requiring at least two drug

reservoirs (*see* col. 3, lines 4-6). Indeed, Hoffmann recites the advantages of having two drug reservoirs in column 3, lines 17-26:

> Due to the fact that, according to the invention, the active substance reservoir is partly detachable whereby the part of the active substance reservoir which is not to be detached has a greater adhesion to the skin than to the back layer, after removing a predetermined plaster part with the active substance reservoir part adhering thereto, there is left behind a predetermined active substance reservoir part on the skin, which can e.g. be alone removed following the desired application period. Advantageously the active substance reservoir of the inventive plaster is in two parts.

Further, Hoffmann believes that three drug reservoirs are also advantageous (*see* col. 3, lines 27-30). Thus, a skilled artisan reading Hoffman would be motivated away from practicing the instant invention.

The Examiner is respectfully reminded that for the Section 103(a) rejection to be proper, both the suggestion and the expectation of success must be found in the prior art, and not in Applicants' own disclosure. In re Dow, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Indeed, hindsight based on Applicants' own success as disclosed and claimed in the present application, is not a justifiable basis on which to contend that the ultimate achievement of the present invention would have been obvious at the time the invention was made. In re Fine, 5 U.S.P.Q.2d 1596, 1599, 1600 (Fed. Cir. 1988).

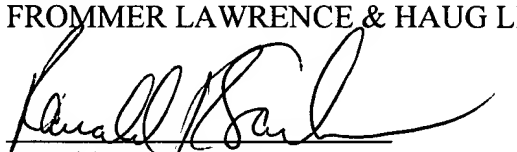
Further, "obvious to try" is not the standard upon which an obviousness rejection should be based. Id. And as "obvious to try" would be the only standard that would lend the Section 103 rejections any viability, the rejections must fail as a matter of law. Therefore, applying the law to the instant facts, the rejections are fatally defective and should be removed.

Consequently, reconsideration and withdrawal of the Section 103(a) rejection is believed to be in order and such actions are respectfully requested.

CONCLUSION

By this submission, the application is in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are all earnestly solicited.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: 

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